

III. Remarks

Claim 1 has been amended to incorporate the limitations of original claims 2-4 which have been canceled. Dependent claims 5 and 6 have been amended and dependent claims 7-13 have been maintained in their original form. Method claims 14-26 have also been cancelled, claims 27-30 have been withdrawn, and claim 31 has been added that depends on claim 1.

The previously presented claims were rejected under 35 U.S.C. §103(a) as being unpatentable over King in view of Simpson et al. It is requested that the examiner reconsider this rejection for the following reasons.

Amended claim 1 recites the use of five cutting blades mounted on a rotating cylinder as follows:

a first cutting blade extending over the circumference of the cylinder and adapted to make a continuous longitudinal cut down the center of the strip to separate the strip into two half portions;

a second cutting blade mounted to the outer surface of the cylinder and extending over approximately one half of the circumference of one of the half portions of the cylinder;

a third cutting blade mounted to the outer surface of the cylinder and extending over approximately the other half of the circumference of the one half portion of the cylinder;

a fourth cutting blade mounted to the outer surface of the cylinder between the first cutting blade and the opposite end of the cylinder and extending over approximately one half of the circumference of the other half portion of cylinder; and

a fifth cutting blade mounted to the outer surface of the cylinder and extending over approximately the other half of the circumference of the other half portion of the cylinder.

As a result, when the cylinder is rotated, the blades engage the sheet; and when there is relative translational movement between the cylinder and the sheet, each blade cuts two shingles upon engaging the material. In this manner by designing the circumference of the cylinder substantially equal to twice the length of each shingle, eight shingles are cut from the sheet upon one rotation of the cylinder.

As the PTO recognizes in MPEP §2142:

The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.

Here, the examiner clearly cannot establish a *prima facie* case of obviousness in connection with amended claim 1 since 35 U.S.C. §103(a) provides that:

[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, King and Simpson et al., alone, or in combination, do not disclose five blades mounted on a cylinder to cut shingles in the manner set forth in amended claim 1.

King is limited to a series of cutting cylinders 30, 72, 84, and 94 and does not mount five blades on one or more of the cylinders to cut shingles in the manner discussed above. Simpson is limited to a cylinder 12 having an assembly 29 of metal die rule members that pierce and score cardboard material and also does not mount five blades (or "rule members" in the case of Simpson) on cylinders to cut shingles in the manner discussed above

Given the above deficiencies in each of the King and Simpson patents, it is apparent that it would be impossible to combine them in any manner, including the manner set forth by the examiner, to meet all of the limitations of amended claim 1.

Therefore, it is impossible to render the subject matter of amended claim 1 as a whole obvious based on any combination of these patents, and the above explicit terms of the statute cannot be met. As a result, the examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to amended claim 1, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the King and Simpson et al. patents cannot be combined and applied to reject amended claim 1 under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Here, King and Simpson et al. do not teach, or even suggest, the desirability of the combination since neither teaches nor suggests providing a cylinder having five blades mounted thereon.

Thus, neither of these patents provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of amended amended claim 1.

In this context, the MPEP further provides at §2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original)

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to amended claim 1. Therefore, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to amended claim 1, and the rejection under 35 U.S.C. §103(a) is not applicable.

In view of all of the above, the allowance of the claims now presented is respectfully requested.

The examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



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